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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,996	12/22/2003	Noriyuki Isobe	9369-67U1 (U01-165196C/KK)	9045
570	7590	11/22/2005	EXAMINER	
AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103			BISSETT, MELANIE D	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/743,996

Applicant(s)

ISOBE ET AL.

Examiner

Melanie D. Bissett

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The rejections have been altered to reflect the new claims.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Although the applicant suggests support for the limitations of claim 26 can be found in example 5, it is noted that the example is not commensurate in scope with the claim. Where the claim encompasses the same two polyamide units chosen from any of the claimed units, the example only teaches one specific set of two polyamide units.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 16-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over AGLC in view of Akkapeddi et al.

6. AGLC discloses adhesives for polyamide materials comprising a phenolic group-containing solvent and a polyamide (abstract). Phenolic solvents are preferred (p. 6) as a solvent, while the polyamide of the substrate is a preferred additive to the solvent (pp. 8-9). Substrates include molded pipes and pipe fittings (pp. 2-3). The reference suggests using the composition to adhere two nylon resins together (pp. 8-9), also suggesting nylon copolymers as substrates (p. 11). However, the reference does not teach the claimed nylon copolymers having two or more of the specific polyamide units.

7. Akkapeddi discloses thermoplastic polymeric molding compositions comprising a blend of a first polyamide and a second copolyamide (abstract). Preferred conventional polyamides for the first polyamide include nylon 12 and nylon 6 (col. 5 lines 20-22), and the second polyamides contain two or more units derived from the claimed monomers (cols. 5-7). The copolyamide contains up to 50% by mole of B₁, where three of the seven exemplary materials have 12 carbon atoms (col. 6 lines 24-33). Preferably, at least 50% by weight of the first polyamide is blended with the copolyamide.

Conventional lubricants, including metal soaps, are added in amounts of 5% by weight or less (col. 10 lines 17-23), while nucleation promoters, including talc, are added in amounts of less than 5% by weight (col. 10 lines 53-63).

8. Akkapeddi teaches the molding materials as having improved strength, toughness, heat resistance, chemical resistance, and gas barrier properties, where the molding materials are useful for forming tubes and molded shapes (col. 11 lines 6-19, 49-68). Thus, it would have been prima facie obvious to use the molding materials of Akkapeddi as pipe or pipe fitting substrates in the AGLC reference to provide articles

having improved strength, toughness, heat resistance, chemical resistance, and gas barrier properties.

9. Regarding the claims limiting the nylon of the adhesive to a copolymerized nylon, AGLC applies as above. However, the reference does not exemplify the use of copolyamide materials in the adhesive. Since the reference suggests that adhesion improves when using the same material in the adhesive as is used in the substrate (pp. 8-9), it is the examiner's position that it would have been prima facie obvious to form a solvent adhesive comprising a phenolic solvent and the same copolymerized nylon of the Akkapeddi molding materials to form an adhesive more well-suited to the copolymerized nylon materials.

Response to Arguments

10. Regarding the AGLC reference's teaching of copolymerized polyamides, the examiner has noted that the reference does not teach the presently claimed *specific* copolyamides having two or more of the claimed polyamide units. However, although the reference suggests homopolyamides, the reference does not exclude or otherwise teach away from using the claimed copolyamides. Rather, the reference teaches that other polyamide materials may be used and suggests that an adhesive can be tailored depending on the moldings chosen.

11. In response to the applicant's arguments of unexpected results, it is the examiner's position that the results are not commensurate in scope with the claims. The examples show only copolyamides made from nylon 6 and nylon 12 units. In Table

1, only one homopolymeric substrate is shown in the working examples, where the nylon resin molding is open to any nylon. Also, the results do not appear to be unexpected. The AGLC reference suggests what is known in the art, that like materials often have stronger adhesion. The comparative examples of Table 2 have used nylon 11, which is nowhere in either substrate. It would be expected that copolymers including nylon 12 units would adhere nylon 12 or nylon 12-containing copolyamides better.

Conclusion


12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (571) 272-1068. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Melanie D. Bissett
Primary Examiner
Art Unit 1711

mdb